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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,236	08/27/2001	Gilbert Garitano	DERMA-06458	4147

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,236

Applicant(s)

GARITANO, GILBERT

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 43.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term “composition” in the preamble of claims 1-30 is used by the claim to mean “composition” while the accepted meaning is “laminate”. The invention does not pertain to a composition, but an article of manufacture. For purposes of examination, the Examiner interprets the term “composition” in the preamble of all claims to mean a laminate.

3. Additionally, regarding claims 1-29, it is not clear as to if CORIAN®, GIBALTAR®, FOUNTAINHEAD®, AVONITE®, or CERATA®, is added in addition to a filled polymeric material, or that it actually is the filled polymeric material. The term “filled” in itself is unclear as it is an indefinite term and not defined in the specification. Also, the use of trademarked terms in claims does not identify or describe the goods associated with the trademark or trade name. Trademarks or trade names are used to identify a source of goods, and not the goods themselves. See MPEP 2173.05(u). Replacement of trademarked terms with a generic description is advised.

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4. Claims 1, 15, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear as to what property the optical density value is assigned to (see limitation, “within about 1.5 of a corresponding transfer image...”), or what “optical density” means.

5. Further it is not clear if a transfer image is a further limitation, or just a description of a fixed image being transferred. Additionally, the phrase “within about” is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN

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6,001,482 to Anderson et al.

Anderson teaches an ink jet image receptor element having a coating. Anderson's ink jet element comprises an image ink-receptive layer adhered to a protective layer comprised of particulate material. Suitable particulate material includes inorganic particles such as silicas, chalk, calcium carbonate, synthetic aluminum and aluminum hydroxide/aluminum trihydrate, and organic particles such as polymeric beads of polymethylmethacrylate. The Examiner takes the position that these particulate materials are equivalent to (a) of claim 1. Anderson notes that such material is used to enhance the smoothness of the ink-receptive surface, particularly after it has been printed, without adversely affecting the transparent characteristics of the element.

While the prior art does not teach the articles having an optical density value, it is an inherent property since the same materials are used. See col. 5, lines 10-25, col. 6, lines 50-68.

8. Claims 1-5 rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,344,269 to Makar et al.

Makar teaches Makar teaches it is known to provide a polymeric material with ink (a fixed image) at col. 3, lines 5-10. Makar teaches polymeric materials such as acrylic resins of ELVACITE®. While Makar does not teach specifically using any other trademarked acrylic resins like CORIAN®, GIBRALTAR®, FOUNTAINHEAD®, AVONITE®, or CERATA®, such use or the compositions of such trademarks are immaterial to patentability since Makar teaches using acrylic resins with ink images in print applications. See further col. 8, lines 53-65.

While the prior art does not teach the articles having an optical density value, it is an inherent property since the same materials are used.

Makar teaches a composition of polymeric materials for forming a lacquer layer

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comprises a polymeric component such as polyester or vinyl (col. 5, lines 12-25, col. 7, and col. 13), and acrylic/PMMA ink such as ELVACITE ® (col. 5, lines 55-58 and col. 9) ranging from 11-25 weight percent, meeting Applicants range of 15-80 of claims 3-5, see examples.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9, 14-23, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,344,269 to Makar et al. in view of USPN 6,203,911 to Weberg et al.

Makar essential discloses the claimed invention as stated above. Makar does not teach adding inorganic fillers in the specific composition as in claims 6-8 and 22. However, Weberg teaches inorganic fillers such as alumina trihydrate can be included in a polymeric material of PMMA from 10 to 75 weight % at col. 8, line 36. Hence it would have been obvious to one of ordinary skill in the art to modify the heat-transfer label of Makar to include alumina trihydrate because the addition increases the strength of a molded article as taught by Weberg at col. 8, lines 1-2.

Makar does not teach the aforementioned trademarked terms, however such terms encompass the ingredients, their amounts, and associated properties of instant claims 2-14, 16-

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28, and 30. Further, Weberg teaches the composition of filled acrylic resins of instant claims 2-14, 16-28, and 30 for article designs. See col. 1, line 59, col. 8, line 36, col. 24, line 42, and col. 25, line 19. Hence, it would have been obvious to one of ordinary skill in the art to modify the invention of Makar to include a filled polymeric material in an image to form a label as taught by Makar, for aesthetic reasons as taught by Weberg at col. 8, lines 41-55.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- "Picture This: Images in Corian" teaches images in acrylic resins such as CORIAN®.
- USPN 5,573,865 to Steelman et al. teaches a graphic transfer article comprising ink printed various ways .
- USPN 5,560,979 to Bloom et al. teaches using acrylic and ink images for transfer applications.
- USPN 5,747,154 to Minghetti et al. teaches acrylic sheeting of PMMA comprising colorant and alumina trihydrate.
- USPN 4,814,220 to Brathwaite teaches using CORIAN®, AVOINITE®, and FOUNTAINHEAD®.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774
November 15, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

